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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,982	01/23/2002	Ned Hoffman	8514-75 (ST-A34)	4646

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MARGER JOHNSON & MCCOLLOM, P.C.
210 SW MORRISON STREET, SUITE 400
PORTLAND, OR 97204

EXAMINER
PICH, PONNOREAY

ART UNIT	PAPER NUMBER
2135	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/056,982	HOFFMAN, NED
	Examiner	Art Unit
	Ponnoreay Pich	2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 February 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>60-114</u> is/are pending in the application.

    4a) Of the above claim(s) <u>83-94 and 104-110</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>60-82, 95-103 and 111-114</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20070503

DETAILED ACTION

Applicant's election without traverse of group I (claims 60-82, 95-103, and 111-114) in the reply filed on 2/28/2007 is acknowledged. Claims 83-94 and 104-110 are withdrawn from consideration. Any new rejections presented below are made in response to applicant's amendments.

Response to Amendment and Arguments

Applicant's amendments were fully considered. Applicant's arguments were also fully considered. Any objections or rejections not repeated below for record are withdrawn due to applicant's amendments and/or arguments. The examiner will only address specific arguments presented by applicant that have not been rendered moot due to amendments or election by applicant.

On page 14 of arguments presented, applicant argues that the amendment to claim 76 overcomes the 101 rejection to claim 76. The examiner respectfully disagrees. It is noted that while applicant has amended the preamble to recite "an identification computer system", a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the preamble indicates the intended use of what is recited in the body of the claim and the body does not depend on the preamble for completeness. It is further unclear how what is recited in the body of claim 76 can

be considered a computer system when a computer system typically is a system comprising both hardware and software components. What is recited in the body of claim 76 can refer to software alone, thus lacks the necessary hardware for the system to be a computer system. As such, it would appear the body of claim 76 refers to a software system rather than a computer system.

With respect to claims 60, 67, 76, and 95 from the elected group, applicant argues that Dunlevy does not teach a set of biometric samples, wherein at least two of the registration biometric samples in the set are each provided by two different registered individuals. Instead, applicant argues that Dunlevy appears to locate a single anchored voice print, i.e. a single sample, rather than a set of registration biometric samples. The examiner respectfully disagrees. While it is true that Dunlevy locates a single anchored sample in a database and compares the anchored sample with what is provided by a user for user verification, the database which contains the anchored sample is itself the set of biometric samples. Dunlevy discloses that when a VRS computer program receives a call, the telephone number acts as a code which identifies the path, the database(s) to apply to that call (col 5, lines 47-col 6, line 5). That is, the phone number is used to locate which database/set of biometric samples to apply to the call. Once that database/set of registered biometric samples has been located, later a single individual anchored sample from the database/set is compared to a received biometric sample provided by an individual. Having to locate the database which might contain the anchored voice print needed for comparison meets the limitation of locating a set of currently stored biometric samples. Since the credit card number provided is

used to identify which anchored voice print in the database is to be retrieved for

comparison (col 8, lines 20-29), this implies that the database of anchored voice prints

contains anchored voice prints belonging to multiple individuals, otherwise the credit

card number would not be needed to find a voice print belonging to a single individual

since all the voice print in the database would belong to that individual. As such, the

database has at least two registration biometric samples that are provided by two

different registered individuals.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 76-82 and 113 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

1. Claim 76 recites in the preamble "an identification computer system". However,

   the body of the claim refers to the system comprising a database, a network

   component, and a comparator. One skilled in the art should appreciate that a

   computer system comprises both hardware and software components, not

   software components alone. Each of these components of the system of claim

   76 can be implemented as software components alone, thus it would appear that

   the body of claim 76 refers to a software system. It is unclear how claim 76 is

   directed towards a "computer system" when no hardware components are

   recited. Claims 77-82 and 113 are dependent on claim 76 and also do not recite

any hardware component, thus it is unclear how these claims refer to a computer system rather than a software system.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 76-82 and 113 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 76 recites an identification system comprising a database, a network component, and a comparator component configured to perform certain actions. One skilled should appreciate that a database can refer to software alone, i.e. SQL or Microsoft Access database. A network component configured to receive data and output data over a communication link can also refer to software alone, i.e. email or FTP programs are software configure to send and receive data over a communication link. Further, comparison can be done via software alone as a comparator component. As such, it appears that the identification system of claim 76 can refer to software per se, which is not patentable. Applicant must recite a component containing hardware as part of the system of claim 76 for the system to be statutory or describe at least one of the components as performing an action which requires that hardware be present to overcome this rejection. Note that the components being configured to perform an action does not mean that the component is performing the action nor does it mean that it is even necessarily capable of performing the action, i.e. an email program such as

Microsoft Outlook is configured/programmed to send and receive email, but that does

not mean that it is necessarily doing so nor does it mean that the program is capable of

doing so at least not until it is installed on proper hardware that is networked properly.

Claims 77-82 and 113 are dependent on claim 76 and also do not recite any hardware,

thus are also not statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed
publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 60-82 and 95-103 are rejected under 35 U.S.C. 102(a) as being

anticipated by Dunlevy (EP 0598469A2).

Claims 60 and 95:

Dunlevy discloses:

1. Receiving a biometric sample from an individual (Fig 2, step 50 and 64).

2. Locating a set, i.e. database, of currently stored registration biometric samples,

    wherein at least two of the currently stored registration biometric samples in the

    set are provided by two different registered individuals respectively (Fig 2, step

    50; col 5, line 47-col 6, line 5; and col 8, lines 20-29).

3. Comparing the received biometric sample with at least one currently stored registration biometric samples in the set of currently stored registration biometric samples to find a match (Fig 2, step 58; col 8, lines 25-35; col 10, lines 48-54; and col 11, lines 31-56).

4. Transmitting a confirmation of the match (Fig 4, step 128 and col 10, lines 48-54).

Claim 60 is a method claim while claim 95 is directed towards a computer readable media storing software to implement the method of claim 60.

Claim 67:

Dunlevy discloses:

1. Receiving a biometric sample from an individual (Fig 2, step 50 and 64).

2. Locating a currently stored set, i.e. database, registration biometric samples, wherein at least two of the registration biometric samples in the currently stored set are provided by two different registered individuals respectively (Fig 2, step 50; col 5, line 47-col 6, line 5; and col 8, lines 20-29).

3. Comparing the received biometric sample with a subset of the currently stored set of registration biometric samples to produce an evaluation (Fig 2, step 58; col 8, lines 25-35; col 10, lines 48-54; and col 11, lines 31-56).

4. Transmitting the evaluation (Fig 4, step 128 and col 10, lines 48-54).

Claims 61, 68, 71, 74, 96, and 101:

Dunlevy further discloses receiving a personal identification code from the individual (col 5, line 47-col 6, line 1; col 7, lines 33-57; and col 8, lines 25-29).

Claims 62, 72, 75, 97, and 102:

Dunlevy further discloses wherein locating a set of currently stored registration biometric samples includes locating the set of currently stored registration biometric samples associated with the personal identification code (col 5, line 47-col 6, line 5; col 7, lines 33-57; and col 8, lines 25-29).

Claims 63 and 98:

Dunlevy further discloses receiving a new registration biometric sample for the individual during a registration step; and string the new registration biometric sample in the set of currently stored registration biometric samples (Figures 1-2 and col 8, lines 36-48).

Claims 64 and 99:

Dunlevy further discloses receiving a personal identification code for the individual during the registration step (col 8, lines 21-48).

Claims 65 and 100:

Dunlevy further discloses wherein storing the new registration biometric sample includes storing the new registration biometric sample in the set of currently stored registration biometric samples associated with the personal identification code (col 8, lines 21-48).

Claims 66, 73, and 103:

Dunlevy further discloses wherein the identification method is conducted without the individual presenting any smartcards or magnetic swipe cards (Figures 1-2). Note that identification is done using only voice identification via a telephone and touch tones on the telephone, thus no cards are presented for identification.

Claim 69:

Dunlevy further discloses wherein each of the registration biometric samples is associated with a personal identification code from the individual (col 5, line 47-col 6, line 5; col 7, lines 33-57; and col 8, lines 25-29).

Claim 70:

Dunlevy further discloses:

1. The method further comprises receiving a personal identification code from the individual (col 5, line 47-col 6, line 1; col 7, lines 33-57; and col 8, lines 25-29).

2. Comparing the received biometric sample includes comparing the received biometric sample with a subset of the currently stored set of registration biometric samples associated with the personal identification code to produce the evaluation (col 5, line 47-col 6, line 5; col 7, lines 33-57; and col 8, lines 25-29).

Claim 76:

As per claim 76, Dunlevy discloses a system comprising a database (col 5, line 47-col 6, line 5), a network component (Fig 6), and a comparator component (Fig 2, step 58) configured to implement the method of claim 60. As such, claim 76 is rejected for much the same reasons given in claim 60

Claim 77:

Dunlevy further discloses wherein the network component is configured to receive a personal identification code from the individual over the communication link (col 5, line 47-col 6, line 1; col 7, lines 33-57; and col 8, lines 25-29).

Claim 78:

Dunlevy further discloses wherein the comparator component is configured to compare the biometric data from the individual with a subset of the registration biometric samples associated with the personal identification code from the individual to determine the identity of the individual (col 5, line 47-col 6, line 5; col 7, lines 33-57; and col 8, lines 25-29).

Claim 79:

Dunlevy further discloses wherein the network component is configured to receive a registration biometric sample for the individual and store the registration biometric sample in the database (col 5, line 47-col 6, line 5; col 7, lines 33-57; and col 8, lines 25-48).

Claim 80:

Dunlevy further discloses wherein the network component is configured to receive the registration biometric sample for the individual a registration personal identification code for the individual and to associate the registration biometric sample with the registration personal identification code in the database (col 5, line 47-col 6, line 5; col 7, lines 33-57; and col 8, lines 25-48).

Claim 81:

Dunlevy further disclose wherein a central computer system is configured to receive the personal identification code from the individual over the communication link, and locate the set of biometric samples associated with personal identification code (col 5, line 47-col 6, line 5; col 7, lines 33-57; and col 8, lines 25-29).

Claims 82 and 103:

Dunlevy further discloses wherein the identification system/method is designed to operate/conducted without the individual presenting any smart cards or magnetic smart cards (Figures 1-2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 111-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlevy (EP 0598469A2) in view of Brunelli et al (US 5,412,738).

Claims 111, 113, and 114:

As per claims 111 and 114, Dunlevy does not explicitly disclose the following limitations, but they are disclosed by Brunelli: wherein comparing the received biometric sample with at least one of the currently stored registration samples includes:

comparing the received biometric sample with a first of the currently stored biometric samples; and if the received biometric sample does not match the first of the currently stored registration biometric samples, comparing the received biometric samples with others of the currently stored biometric samples until either a match is found or the received biometric sample has been compared with each of the currently stored biometric samples (col 6, lines 50-65; col 7, line 66-col 8, line14; and col 12, lines 59-65).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to further modify Dunlevy's invention according to the limitations recited in claims 111 and 114 as per Brunelli's teachings. One skilled would have been motivated to do so because not only would it allow Dunlevy to verify the identity of an individual involved in a transaction, but it would also allow for the specific identification of an individual in an optimal manner (Brunelli: col 2, lines 3-10). This could lead to the faster arrest of individuals who fraudulently uses someone else's account without their permission in cases where the unauthorized users also possess their own respective accounts.

Claim 113 is directed towards a system with a comparator that is operative to perform the method of claim 111 and is rejected for similar reasons given above.

Claim 112:

As per claim 112, Dunlevy does not explicitly disclose the following limitation, but it is disclosed by Brunelli: wherein comparing the received biometric samples with a subset of the currently stored set of biometric samples to produce an evaluation

includes comparing the received biometric samples with at least two registration

biometric samples in the subset of the currently stored set of registration biometric

samples to produce an evaluation, the subset of the currently stored set of registration

biometric samples includes at least two registration biometric samples (col 6, lines 44-

54; col 7, lines 27-43; and col 13, lines 25-27).

At the time applicant's invention was made, it would have been obvious to one

skilled in the art to modify Dunlevy's invention according to the limitations recited in

claim 112 as per Brunelli's teachings by comparing more the received biometric

samples with at least two registration biometric samples. One skilled would have been

motivated to do so because the recognition ability of Dunlevy's system would be

improved by use of more than one sample of the person to be

recognized/identified/verified (Brunelli: col 13, lines 25-27).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

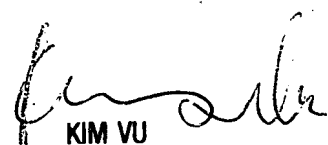than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-

7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

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Ponnoreay Pich
Examiner
Art Unit 2135

PP

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 210